

Appl. No.: 09/977,894  
Amdt. Dated 12/07/2006  
Reply to Office Action of 08/08/2006

### **REMARKS**

This amendment is submitted with a request for a one month extension and appropriate fee in reply to the outstanding Office Action dated August 8, 2006. Claims 1-22 currently stand rejected. Applicants have amended independent claims 1, 7 and 15 to more particularly distinguish the claimed invention from the cited references. Newly added claims 23-25 have been added to further define patentable aspects of the invention. No new matter has been added by the amendment.

In light of the amendment and the remarks presented below, Applicants respectfully request reconsideration and allowance of all now-pending claims of the present application.

#### **Claim Rejections - 35 USC §112**

Claims 1, 7 and 15 stand rejected under 35 U.S.C. §112, second paragraph as being indefinite. Specifically, the Office Action states that the term “the existence” from independent claims 1, 7 and 15 lacks antecedent basis. Applicants have amended independent claims 1, 7 and 15 to recite instead --existence-- as previously interpreted by the Examiner.

The Office Action also states that the phrase “whether to share” of independent claim 1 does not specifically limit the scope of the claim, since it is alleged that “whether” introduces many possibilities on the claim limitations and makes the scope of the claim vague and indefinite. Applicants respectfully disagree with this analysis. In this regard, Applicants respectfully point out that there are not many possibilities, but merely two (i.e., sharing and not sharing) which are introduced by the phrase “whether to share”. Additionally, Applicants can see no other possible interpretations for the phrase. Accordingly, since the phrase clearly only provides the intended two possible limitations with respect to sharing a digital library work, it is respectfully asserted that the phrase “whether to share” is not indefinite.

Accordingly, for the reasons stated above, Applicants submit that the rejections of claims 1, 7 and 15 under 35 U.S.C. §112 are overcome.

#### **Claim Rejections - 35 USC §103**

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Claims 1-4, 7, 8, 10, 13, 15, 16, 18 and 21 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Abdehnur et al. (U.S. Patent No. 6,212,640, hereinafter “Abdehnur”) in view of Hooper et al. (U.S. Patent No. 5,414,455, hereinafter “Hooper”) and further in view of Grube et al. (U.S. Patent No. 5,594,796, hereinafter “Grube”). Claims 5, 11 and 19 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Abdehnur in view of Hooper and Grube, and further in view of Wiser et al. (U.S. Patent No. 6,385,596, hereinafter, “Wiser”). Claims 6, 12 and 20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Abdehnur in view of Hooper and Grube, and further in view of Moskowitz (U.S. Patent No. 6,598,162). Claims 9 and 17 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Abdehnur in view of Hooper and Grube, and further in view of Halabieh (U.S. Patent No. 6,564,170). Claims 14 and 22 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Abdehnur in view of Hooper and Grube, and further in view of Natarajan (U.S. Patent No. 6,611,599).

Applicant has amended independent claims 1, 7 and 15 to recite, *inter alia*, the decision regarding shareability being based only on existence of the identifier in the digital literary work. Thus, in an exemplary embodiment according to independent claims 1, 7 and 15, a digital literary work is examined for the existence of an identifier and shared based only on the existence of the identifier.

Abdehnur is directed to a method and apparatus for sharing resources in a network environment. However, Abdehnur is silent, as conceded in the Office Action, regarding a digital literary work including an identifier. As such, the Office Action cites Hooper as teaching such feature at Figure 3 and col. 6, lines 13-15. The cited passage from Hooper discloses a video (100) that includes packets (110) having a packet header (120) and packet data (140) (col. 6, lines 7-11, Figure 3). The packet header (120) includes an ID (121), a RATE (122), a TIME-STAMP (123), and a PACKET-SIZE (125). It should be noted that the ID (121) identifies the particular video. However, none of the ID (121), the RATE (122), the TIME-STAMP (123), or the PACKET-SIZE (125) is used as a basis for a determination as to whether to share the video (100). Accordingly, Hooper fails to teach or suggest that the decision regarding shareability being based only on existence of the identifier in the digital literary work as claimed in independent claims 1, 7 and 15.

In order to cure the deficiency of Abdehnur and Hooper, the Office Action cites Grube. Specifically, the Office Action alleges that the recited feature is disclosed by virtue of the security tag of FIGS. 1, 2, 3 and the description at col. 5, lines 50-60 and col. 6, lines 33-45 and 65-66 of Grube.

Grube is directed to a method and apparatus for detecting unauthorized distribution of data. In this regard, Grube discloses that a security tag may be searched for (operation 301 of FIG. 3) in response to the receipt of data from a particular data base (operation 300 of FIG. 3). However, in Grube the existence of the security tag is not used to determine whether to share data, but instead is only used for determining whether to add a security tag or examine an existing tag for a match with a stored database identification. Grube goes on to disclose an additional determination regarding whether a security tag is valid by comparing a detected security tag to a stored database identification (col. 5, lines 50-54). If the security tag is valid, it is ignored (col. 5, lines 55-56). However, if the security tag is invalid, then the authorized distributor is informed (operation 307 of FIG. 3). As such, a decision regarding whether to share data according to Grube is not based on the existence of an identifier. Instead, Grube merely uses the existence of an identifier to determine whether to add an identifier and the identifier is subsequently examined for validity to determine whether to inform an authorized distributor of an unauthorized distributor. Accordingly, there is not even a decision regarding whether to share data in Grube, much less determining whether to share data based only on the existence of an identifier. Thus, Grube fails to teach or suggest that the decision regarding shareability being based only on existence of the identifier in the digital literary work as claimed in independent claims 1, 7 and 15.

Halabieh is directed to customizable user interfaces. Natarajan, Moskowitz and Wiser are each directed to encryption methods. Halabieh, Natarajan, Moskowitz and Wiser each fail to teach or suggest that the decision regarding shareability being based only on existence of the identifier in the digital literary work as claimed in independent claims 1, 7 and 15. Furthermore, none of Halabieh, Natarajan, Moskowitz and Wiser is cited as disclosing such feature.

Since Abdehnur, Hooper, Grube, Halabieh, Natarajan, Moskowitz and Wiser each fail to teach or suggest the same aforementioned feature of independent claims 1, 7 and 15, any

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combination of Abdeinur, Hooper, Halabieh, Natarajan, Moskowitz and Wiser also fails to teach or suggest the subject matter of independent claims 1, 7 and 15. Thus, the cited references, taken either individually or in combination, do not anticipate, or render independent claims 1, 7 and 15 obvious. Claims 2-6, 8-14 and 16-22 depend either directly or indirectly from a respective one of independent claims 1, 7 and 15, and as such, include all the recitations of their respective independent claims. The dependent claims 2-6, 8-14 and 16-22 are therefore patentably distinct from the cited references, individually or in combination, for at least the same reasons as given above for independent claims 1, 7 and 15.

Accordingly, Applicants respectfully submit that the rejections of claims 1-22 are overcome.

**Newly Added Claims**

Applicants have added new claims 23-25 to more particularly define aspects of the present application. The new claims include no new matter and are fully supported by the specification and the drawings of the present application.

Accordingly, it is believed that the new claims are in condition for allowance.

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### **CONCLUSION**

In view of the amended claims and the remarks submitted above, it is respectfully submitted that the present claims are in condition for immediate allowance. It is therefore respectfully requested that a Notice of Allowance be issued. The Examiner is encouraged to contact Applicants' undersigned attorney to resolve any remaining issues in order to expedite examination of the present invention.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,



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